

REMARKS

Claims 1-22 are pending in the application. Claims 1-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gupta (U.S. Patent No. 6,204,858) (“Gupta”) and Acker et al. (U.S. Patent No. 6,009,209) (“Acker”). Claims 14-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gupta and Acker, and further in view of Benati et al. (U.S. Patent No. 5,432,863) (“Benati”). Applicant adds new claims 23-35 to more particularly claim the invention and to submit the following arguments to traverse the prior art rejections.

Applicant’s invention relates to a method of setting a region to be subjected to red eye correction for correcting a red eye in an image and a red eye correcting method of correcting the set region to be subjected to red eye correction in an embodiment.

Gupta relates to adjusting color data of pixels of a digital image by identifying pixels of a digital image having original color data corresponding to predetermined color and shape characteristics and adjusting the original color data of the identified pixels to achieve a desired result. Acker relates to an apparatus and method for editing a digital color image to remove discoloration of the image.

Applicant respectfully submits that claim 1 is patentable because Gupta and Acker both fail to teach, suggest, or provide motivation for a step of setting a second region to be subjected to red eye correction for correcting color of the pupil into said specified color of the pupil, in combination with other elements of the claim.

In the Office Action, the Examiner states that the candidate area automatically extracted from the first area, and that the candidate area is set as the second region. To the contrary, claim 1 recites “automatically extracting only the red eye from a first region . . . ; and setting a second

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region to be subjected to red eye correction,” in combination with other elements of the claim.

In other words, if the Examiner asserts that the candidate area is the area which is automatically extracted, then the Examiner cannot assert that the candidate area is also analogous to the second region, as claimed.

Further, Applicant respectfully submits that the Examiner is incorrect in stating that the combination of references teaches or suggests that if only the red eye can not automatically be extracted, setting said second region to be subjected to red eye correction by designating only the red eye by the operator manually. While the Examiner concedes that “Gupta is silent to setting the second region by manual designation if the redeye cannot be automatically extracted,” the Examiner has not shown how Acker teaches or suggests such a step and merely states that “those skilled in the art would have known.” Applicant submits that such conclusory remarks are improper and that the Examiner provide prior art to substantiate such knowledge of one skilled in the art.

Additionally, the Examiner has not established a *prima facie* case of obviousness because the references fail to suggest the desirability of the modifying Gupta with Acker. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. 2143.01 *citing* In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). While Gupta discloses that candidate areas, i.e., red eyes, are automatically identified, there is nothing in the reference which suggests the desirability of having manual identification. Acker teaches the manual identification of red eyes and do not suggest the desirability of automatic identification of such areas. In effect, each

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of the references teaches away from the teachings of the other. By combining the references, Applicant submits that the Examiner has engaged in impermissible hindsight.

Moreover, to the extent any automatic identification is combined with manual identification, the result would be two separate processes, one performed manually and one separately performed automatic determination. Applicant's invention provides a contingent manual determination in case the automatic determination does not succeed.

For reasons similar to those submitted for claim 1, claim 7 is patentable.

Claims 2-6 and 8-13, which depend from claims 1 and 7, respectively, are patentable for at least the reasons submitted for claims 1 and 7.

Claims 14-22 are rejected under § 103(a) as being unpatentable over Gupta and Acker, and further in view of Benati. Benati relates to a method for determining and correcting for eye color defects in an image due to flash illumination.

Applicant submits that claims 14-22, which depend from claim 7, are patentable for at least the reasons submitted for claim 1 and because Benati fails to make up for the deficiencies of Gupta and Acker.

Alternatively, or in addition, claim 20 is patentable because Benati fails to teach or suggest the first image data being prescanned image data whereas said second image data is fine scanned image data. Although Benati teaches images at different resolutions, there is no teaching or suggestion of images scanned at different levels.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

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Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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